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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,592	03/24/2004	Gregory C. Franke	200314727-1	3635

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EXAMINER	
MITCHELL, KATHERINE W	
ART UNIT	**PAPER NUMBER**
3677	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/807,592	FRANKE ET AL.	
	Examiner	Art Unit	
	Katherine W. Mitchell	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 August 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) *27,28 and 31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26,29,30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 27,28,31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/10/2005.

A complete reply to any final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

3. Claim12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 contains the trademark/trade name TORX®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe

a star-shaped recess in a fastener head and, accordingly, the identification/description is indefinite.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-8 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Sihon USP 5397206.

Sihon teaches a fastener comprising an integrated isolation member 28 composed of resilient material (abstract-rubber grommet), capable of isolating a storage drive and capable of fitting within a slot of the drive cage and abutting a drive cage surface. There is an outer wall and axial portion - see Fig 1. If "12" were the drive cage, "46' would be the ribs which invert and abut a drive cage surface - see Fig 1 to 2 to abutment.

rib (rĭb) *noun*

2. A part or piece similar to a rib and serving to shape or support: *the rib of an umbrella.* [1]

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[1]Excerpted from *The American Heritage Dictionary of the English Language, Third Edition* Copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from Lernout & Hauspie Speech Products N.V., further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

Threaded fastener (22/20) is shown in the Figures, and has a head capable of tightening the fastener, and a washer (34) upon which the isolation member is provided, located between the head and threaded stud. A shaft (30) extends between head and threaded stud, and the washer is mounted on and contacts the shaft the shaft (Figures).

6. Claims 1-3, 5-8, are rejected under 35 U.S.C. 102(b) as being anticipated by Antoine et al USP 6227784

Antoine et al teaches a fastener comprising an integrated isolation member composed of resilient material, capable of isolating a storage drive and capable of fitting within a slot of the drive cage and abutting a drive cage surface. Col 2 lines 57-67 teach an isolation member made of thermoplastic elastomeric material.

7. Claims 1,3, 5-8, are rejected under 35 U.S.C. 102(b) as being anticipated by Lin et al USP 6917520.

Lin teaches a fastener comprising an integrated isolation member (Fig 1) composed of a resilient material (body 34 described as compressed in abstract, and since it is described as for absorbing shock, it is inherently resilient). It is capable of fitting within a drive cage slot (Fig 3 - unit 1/10/20/30 could clearly fit in a slot) and it would abut a cage surface when so engaged. It has an outer wall and axial portion (Fig 1) and threaded stud (16), head (10's surface 1--see Fig 3) and shaft (15)-mounted washer (20) between head and stud.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 9-14, 17-20, and 22-26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Felcman et al USP 6122173 in view of Grassens et al USP 4683520.

Felcman teaches a drive 40 with an outer housing 12 with slots (Fig 2A and 2B) and fasteners 50 mounted to the ends of the drive. However, the fasteners are not taught as having a resilient or elastomeric isolation member or having a washer mounted on the shaft between the head and stud. Grassens teaches fasteners with resilient isolation members in Figs 1 and 2, and col 2 lines 30-41 teach that resilient isolation members are well known to be used to absorb shock and vibrations for mounting electrical apparatus to a chassis, and col 2 lines 30-41 are specific that a washer can be used such that a resilient isolation member is provided on the washer between the washer and the head when the mounting surface is irregular or resilient. Note that "36" is NOT considered part of the Grassens fastener or the modified Felcman/Grassens fastener. The isolation member includes an outer wall and an axial portion. Were the fastener 50 of Felcman modified per Fig 4 of Grassens, (excluding "36" which would not be part of the modified fastener), the outer wall would be capable of abutting the drive cage surface and the axial portion would fit within the drive cage slot. The metal head, shaft, and threaded stud are a single unit (screw), and the threaded stud is considered the part as labeled below:

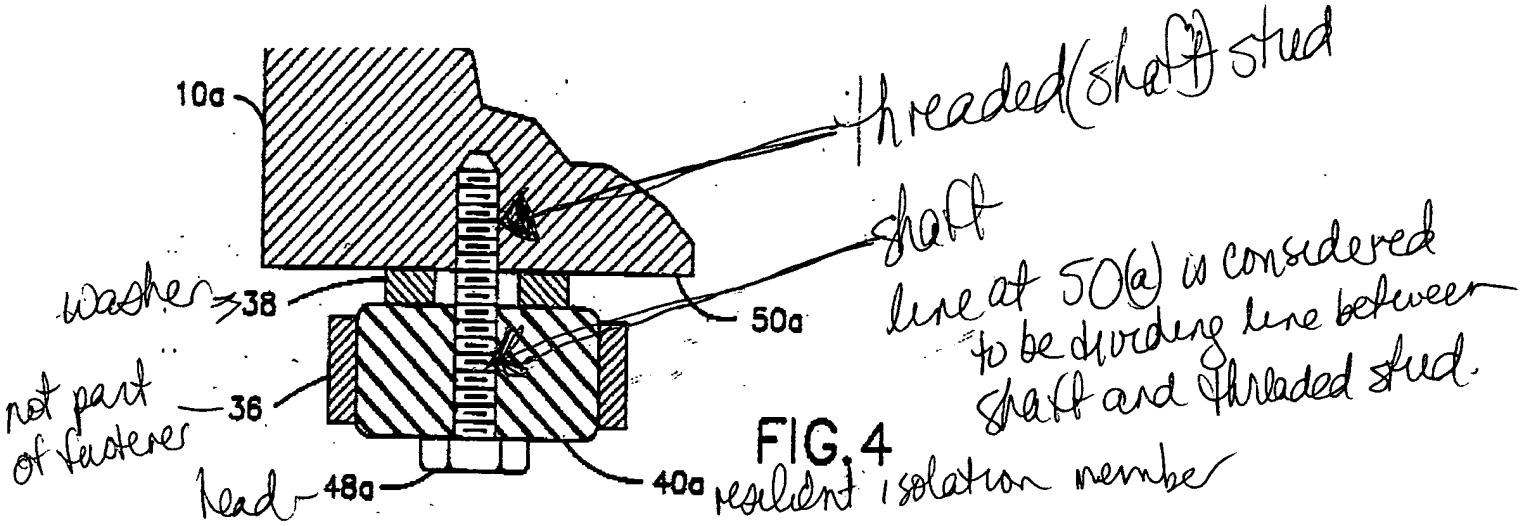


FIG. 4

Washer 38 is in contact with the shaft via its contact with intermediate member 40a. Absent any further limitation, the washer axial portion is approximately the same diameter as the outer head diameter. Examiner takes Official Notice that it is old and well known in the art to have resilient isolation members made of thermoplastic elastomers to dampen vibrations, and to have a fastener head selected from commonly used fastener heads to coordinate with existing drivers.

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Felcman and Grassens before him at the time the invention was made, to modify Felcman in view of Grassens to include the resilient isolation member of Grassens, in order to obtain shock and vibration dampening. One would have been motivated to make such a combination because computer drives are subject to such shock and vibrations, which can damage the devices without a means to minimize the shock and vibrations.

Further Re claims 13 and 18 and 30: in an apparatus claim, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Further Re claims 19: Felcman teaches a storage media drive, (Fig 2A and 2B) with the outer housing defining the ends of the drive.

Further Re claim 22: "50' of Felcman is described as a screw head (col 7 lines 1-14), thus clearly there were openings for the fasteners to be threaded into since only the head is visible.

Further Re claims 25-26: The type of drive, including magnetic hard drive or optical drive, is taught by Felcman in col 3 lines 42-53.

10. Claims 15-16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Felcman et al USP 6122173 in view of Grassens et al USP 4683520.and further in view of Lin et al USP 6917520. As discussed above, Felcman in view of Grassens teach all the elements except ribs extending radially from the isolation member axial portion to the outer wall, having a height greater than the outer wall height. Lin teaches such ribs 33 on a resilient isolation member 32, (col 2 lines 33-46, Fig 1) such that, per Fig 3 and col 3 lines 13-16, the ribs absorb shock to prevent transferring such shock or vibrations to the surface 42 against which the member 32 would otherwise lie flat against. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Felcman in view of Grassens and Lin before him at the time the invention was made, to modify Felcman in view of Grassens as taught by Lin to include radially extending ribs extending higher than the top surface of the resilient member, in order to obtain enhanced shock and vibration damping. One would have been motivated to make such a combination because better protection of the drive would have been obtained, as taught/suggested by Lin in col 3 lines 13-14.

Conclusion

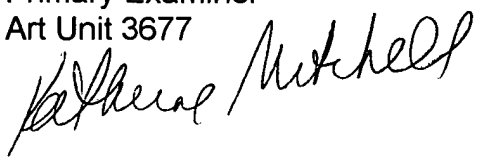
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell
Primary Examiner
Art Unit 3677



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